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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,499	12/27/2001	Gary Wayne Reis	REIS 0101	8403
24507	7590	11/28/2003		
MICHAEL BLAINE BROOKS, A PROFESSIONAL CORPORATION 5010 NO. PARKWAY CALABASAS SUITE 104 CALABASAS, CA 91302-3913			EXAMINER CARTER, MONICA SMITH	
			ART UNIT 3722	PAPER NUMBER 8
DATE MAILED: 11/28/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,499

Applicant(s)

REIS, GARY WAYNE

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-14, 16-18 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald ('898) in view of Maude, Sr. ('070).

McDonald discloses a rectangular sheet (10- as seen in figure 4) of foldable material having an upper side and a reverse side, the sheet having a plurality of substantially parallel primary folds (12) forming a series of panels that inwardly rotate towards the upper side from an unfolded configuration to a folded configuration (As seen in figure 4, the side along 28 closest to portion 16 is considered to be the upper side and the side along 28 closest to portion 18 is considered to be the lower side. As seen in col. 3, lines 61-67, the portion 18 is brought into contact with portion 16 as indicated by arrow 38 until the sheet reaches the position shown in figure 3. In doing so, the primary folds would inwardly rotate towards the upper side.) in which the series of panels are foldably arranged one atop another; one or more secondary folds (14) in the sheet substantially perpendicular to the plurality of substantially parallel primary folds forming sub-panels which are foldably perpendicular to the primary folds; wherein one of the sub-panels forms a front cover (20) of the booklet and one of the sub-panels forms a rear cover (22) of the booklet.

McDonald discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claims. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia in the booklet since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In *re* Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of booklet does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability. Further, Maude, Sr. discloses a golf score card (10) comprising a rectangular sheet (as seen in figure 1) containing graphic depictions of the holes of a golf course including "the general layout of the golf hole, from tee box to green, with the optional illustration of bunkers, hazards, and other obstacles." (see col. 1, lines 60-68). Maude, Sr. also discloses that "other suitable course information can be provided, such as shown at 22, to assist the player and scorer using the golf score card 10." (see col. 3, lines 10-12). As seen in figure 1, a matrix (12) is provided to keep score on a hole-by-hole basis for several players. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify McDonald's invention to include graphic depictions of a golf

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course on the foldable sheet, as taught by Maude, Sr., to provide a convenient, portable device that gives a golfer a quick reference of the golf course and enables scoring recordation.

Regarding claims 3 and 11, it would have been obvious to provide information on both the upper and reverse side of the sheet, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 5 and 13, McDonald, as modified by Maude Sr., discloses that the substrate is markable (see Maude, Sr. col. 1, lines 54-59).

Regarding claims 6 and 14, it would have been advantageous and obvious to one having ordinary skill in the art to provide the booklet dimensioned to be insertable within clothing pockets, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, making the booklet pocket-sized enables the golfer to easily carry the booklet along as he/she plays the game.

Regarding claims 8 and 16, the primary folds are substantially evenly spaced (as seen in McDonald, figure 4).

Regarding claims 9-12, see the above rejections to claim 1.

Regarding claim 17, see the above rejections to claim 1. Further, as seen in figure 3, when the panels (bottom- segment 20 adjacent to portion 16, center- segments located between 20 and 10, top- segment 10 adjacent to portion 18, left-segment

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adjacent lower edge portion 30 and right- segment adjacent upper edge portion 30) are folded along their fold lines, the bottom panel would cover the center panel, the top panel would cover both the bottom and center panels and the left panels would cover the right panels.

Regarding claim 18, McDonald, as modified by Maude, Sr., discloses the claimed invention except for the orientation of the printed information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the information at any desired location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of booklet does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claim 20 (the booklet being a golf score and golf playing booklet having course information), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art

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structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 21, McDonald, as modified by Maude, Sr., discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia in the booklet since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of booklet does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claims 22 and 23, it would have been an obvious matter of design choice to provide any desired dimensions for the booklet, since such a modification would have involved a mere change in the size of a component. A change in size is

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generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

3. Claims 7, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald in view of Maude, Sr. and further in view of Kelly ('431).

McDonald, as modified by Maude, Sr., discloses the claimed invention except for a sheet of paper being inserted inside the folded form of the booklet, the insert containing promotional materials and information and instructions on the use of the booklet.

Kelly discloses a folded booklet (10) having insert pages (12). The insert is printed with promotional information, which could include use instructions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the insert pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of insert does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for

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patentability. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify McDonald's invention to include an insert, as taught by Kelly, to provide the booklet with removable promotional information to portray a particular message to the user.

Response to Arguments

4. Applicant's arguments filed September 10, 2003 have been fully considered but they are not persuasive.

Applicant argues that McDonald, as modified by Maude, Sr., fails to disclose the invention as presently amended. The examiner disagrees. As set forth above, McDonald, as modified by Maude, Sr. discloses the inwardly folded upper and lower panels as set forth in the above rejections.

For the reasons as set forth above, the rejections are maintained.

Note: Claim 9 in applicant's amendment is designated as being "original"; however, claim 9 has been amended.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


MONICA S. CARTER
PRIMARY EXAMINER

November 26, 2003